



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,792	07/30/2003	Takeshi Kato	011350-314	9403

21839 7590 02/07/2006

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

LIN, SHEW FEN

ART UNIT PAPER NUMBER

2166

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,792	Applicant(s) KATO, TAKESHI	
	Examiner Shew-Fen Lin	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/30/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- a. This action is responsive to application filed on 7/30/2003, IDS filed on 7/30/2003.
- b. The application claims foreign priority, 2002-221459, Japan (filed on 7/30/2002).
- c. Claims 1-14 are pending. Claims 1, 4, 5, 6, 7, 8, 9, 11, and 13 are independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Jasinski (US Publish 2003/0105880).

As to claims 1, 9, and 10, Jasinski discloses a system with methods /means / system of a file storage device (home computer, Figure 1, item 12) that is capable of communicating with a portable terminal (mobile unit, Figure 1, item 14), comprising:

Art Unit: 2166

a text information extracting part for extracting text information for a specified file (downside the requested text information, Figures 3 and 4, paragraph [0019]) in response to a request from said portable terminal (paragraph [0017]); and

a text information transmitting part for transmitting the text information extracted by said text information extracting part to said portable terminal (paragraph [0020]).

Claims 1, 2, 6, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US Publish 2002/0113994, hereinafter referred as Smith).

As to claims 1, 9, and 10, Smith discloses a system with methods /means / system of a file storage device (server, Figure 1, item 1) that is capable of communicating with a portable terminal (cellular phone, PDA, Figure 1, item 125, 119), comprising:

a text information extracting part for extracting text information for a specified file (truncate information, Figure 3B, Figure 9A, item 903, paragraph [0045], lines 1-3) in response to a request from said portable terminal (request information, Figure 9A, item 901, paragraph [0025], lines 15-17, paragraph [0026], lines 1-2) ; and

a text information transmitting part for transmitting the text information extracted by said text information extracting part to said portable terminal (Figure 3b, Figure 9A, item 906, paragraph [0027], lines 1-7, paragraph [0045], lines 4-5).

Art Unit: 2166

As to claim 2, Smith discloses wherein said text information is a heading in the data included in said specified file (headline information is transferred, Figure 3B, Figure 7B, paragraph [0022], lines 23-31).

As to claim 6, Smith discloses a printing system, comprising:

a file storage device for storing a file (server, Figures 1 and 2, item 1, paragraph [0020], lines 3-5); a printing device (Figures 1 and 2, item 115, paragraph [0021], lines 4-5) communicable with said file storage device; and a portable terminal (cellular phone, PDA, Figure 1, items 125, 119, paragraph [0021], lines 6-9) communicable with said file storage device, wherein a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal (mobile device sends print request to printer for full length information, Figure 3C, item 311, Figure 7B, item 709, Figure 9B, item 939, paragraph [0024], paragraph [0027], lines 14-16, paragraph [0045], lines 14-21);

said file storage device including: a text information extracting part for extracting text information for a specified file (truncate information, Figure 3B, Figure 9A, item 903, paragraph [0045], lines 1-3) in response to a request from said portable terminal (request information, Figure 9A, item 901, paragraph [0025], lines 15-17, paragraph [0026], lines 1-2) ; and a text information transmitting part for transmitting the text information extracted by said text information extracting part to said portable terminal (Figure 3b, Figure 9A, item 906, paragraph [0027], lines 1-7, paragraph [0045], lines 4-5).;

Art Unit: 2166

said portable terminal including: a display part for displaying the text information received from said file storage device (display truncated information, Figure, 3B, Figure 7B, Figure 9A, item 909, paragraph [0007], paragraph [0045], lines 7-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 1 above, and further in view of Palmer et al. (US Patent 6,002,798, hereinafter referred as Palmer).

As to claim 3, Smith discloses the elements of claim 1 as noted above but does not explicitly disclose wherein said text information is obtained by recognizing characters from character image in the image data included in said specified file.

Palmer discloses using optical character recognition technique to convert image into text for indexing and abstract (Figure 4, column 3, lines 10-15).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include selecting text information from image data of information as taught by Palmer for the purpose of retrieving /browsing information quickly (column 1, lines 30-39, Palmer). The skilled artisan would have been motivated to improve the invention of Smith per the above such that information can be previewed using text only section (column 2, lines 17-20, Palmer).

Claims 4, 7, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Microsoft Word 2000 (Microsoft Corporation, 1993-1999, hereinafter referred as MS-Word).

As to claims 4, 11, and 12, Smith discloses a system with methods /means / system of a file storage device (server, Figures 1 and 2, item 1, paragraph [0020], lines 3-5) that is capable of communicating with a portable terminal (cellular phone, PDA, Figure 1, items 125, 119,

Art Unit: 2166

paragraph [0021], lines 6-9) and a printing device (Figures 1 and 2, item 115, paragraph [0021], lines 4-5), comprising:

an aggregate image generating part for generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file in response to a request from said portable terminal (aggregate information based on selected template, Figure 7E, paragraph [0039], lines 1-10); and

an aggregate image transmitting part for transmitting the aggregate image generated by said aggregate image generating part to said printing device (print the selected template, paragraph [0039], lines 19-22).

Smith does not explicitly disclose generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file.

MS-Word discloses generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file by selecting preview/print option (Pages 2-4).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include thumbnail printing as taught by MS-Word for the purpose of providing viewer to see at a glance where information fall in the specified file (Page 3, MS-Word). The skilled artisan would have been motivated to improve the invention of Smith per the above such that information can be previewed easily (Page 3, MS-Word).

Art Unit: 2166

As to claim 7, Smith discloses A printing system, comprising:

a file storage device for storing a file (server, Figures 1 and 2, item 1, paragraph [0020], lines 3-5); a printing device (Figures 1 and 2, item 115, paragraph [0021], lines 4-5) communicable with said file storage device; and a portable terminal (cellular phone, PDA , Figure 1, items 125, 119, paragraph [0021], lines 6-9) communicable with said file storage device, wherein a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal (mobile device sends print request to printer for full length information, Figure 3C, item 311, Figure 7B, item 709, Figure 9B, item 939, paragraph [0024], paragraph [0027], lines 14-16, paragraph [0045], lines 14-21);

said file storage device including: an aggregate image generating part for generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file in response to a request from said portable terminal (aggregate information based on selected template, Figure 7E, paragraph [0039], lines 1-10); and an aggregate image transmitting part for transmitting the aggregate image generated by said aggregate image generating part to said printing device (print the selected template, paragraph [0039], lines 19-22),

said printing device including: a printing part for printing the aggregate image received from said file storage device (print the selected template, paragraph [0039], lines 19-22).

Smith does not explicitly disclose generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file.

MS-Word discloses generating an aggregate image consisting of a plurality of thumbnail images arranged within the same page for a specified file by selecting preview/print option (Pages 2-4).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include thumbnail printing as taught by MS-Word for the purpose of providing viewer to see at a glance where information fall in the specified file (Page 3, MS-Word). The skilled artisan would have been motivated to improve the invention of Smith per the above such that information can be previewed easily (Page 3, MS-Word).

Claims 5, 8, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Blumberg (US Patent 6,449,639).

As to claims 5, 13, and 14, Smith discloses a system with methods /means / system of a file storage device (server, Figures 1 and 2, item 1, paragraph [0020], lines 3-5) that is capable of communicating with a portable terminal (cellular phone, PDA, Figure 1, items 125, 119, paragraph [0021], lines 6-9), comprising:

a thumbnail image transmitting part for transmitting a thumbnail image for a specified file (compressed image or graphics to fit the display, paragraph [0037]) to said portable terminal in response to a request from said portable terminal;

an enlarged image generating part for generating an enlarged image for said thumbnail image in response to a request from said portable terminal (recall full length information flag, Figure 11B) ; and

Art Unit: 2166

an enlarged image transmitting part for transmitting the enlarged image generated by said enlarged image generating part to said portable terminal (sent the full length information to portable device, paragraph [0053]).

Smith does not explicitly disclose generating an enlarged image for said thumbnail image.

Blumberg discloses receiving a thumbnail image and generating a scalable document by zooming (Figure 4A/B/C, column 11, lines 57-67, column 12, lines 18-28, column 16, lines 10-17).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include zooming thumbnail as taught by Blumberg for the purpose of providing interactive zooming a portion of the page (column 12, lines 21-28, Blumberg). The skilled artisan would have been motivated to improve the invention of Smith per the above such that information can be easily previewed.

As to claim 8, Smith discloses a printing system, comprising:

a file storage device for storing a file (server, Figures 1 and 2, item 1, paragraph [0020], lines 3-5); a printing device (Figures 1 and 2, item 115, paragraph [0021], lines 4-5) communicable with said file storage device; and a portable terminal (cellular phone, PDA , Figure 1, items 125, 119, paragraph [0021], lines 6-9) communicable with said file storage device, wherein a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal (mobile device sends print request to printer for full

Art Unit: 2166

length information, Figure 3C, item 311, Figure 7B, item 709, Figure 9B, item 939, paragraph [0024], paragraph [0027], lines 14-16, paragraph [0045], lines 14-21);

said file storage device including: a thumbnail image transmitting part for transmitting a thumbnail image for a specified file (compressed image or graphics to fit the display, paragraph [0037]) to said portable terminal in response to a request from said portable terminal; an enlarged image generating part for generating an enlarged image for said thumbnail image in response to a request from said portable terminal (recall full length information flag, Figure 11B) ; and an enlarged image transmitting part for transmitting the enlarged image generated by said enlarged image generating part to said portable terminal (sent the full length information to portable device, paragraph [0053]);

said portable terminal including: a display part for displaying the thumbnail image and the enlarged image received from said file storage device (Figure 11B, paragraph [0053]).

Smith does not explicitly disclose generating an enlarged image for said thumbnail image.

Blumberg discloses receiving a thumbnail image and generating a scalable document by zooming (Figure 4A/B/C, column 11, lines 57-67, column 12, lines 18-28, column 16, lines 10-17).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include zooming thumbnail as taught by Blumberg for the purpose of providing interactive zooming a portion of the page (column 12, lines 21-28, Blumberg). The skilled artisan would have been motivated to improve the invention of Smith per the above such that information can be easily previewed.

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Utsumi; Masaki, US 5966451 A, "Distributed network computing system, and data exchange apparatus and method and storage medium used in this system", (...the service data is converted into a predetermined format on the basis of the attribute of a communication network connected to the terminal and transmitted, the application service can be provided while absorbing the relative difference in communication capability among communication networks).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2166

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2166
January 24, 2006

Shew-Fen Lin
Patent Examiner



MOHAMMAD ALI
PRIMARY EXAMINER